



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,888	11/27/2002	Chandra S. Bajgur	126139-1	5289
23413	7590	10/28/2003		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002				
EXAMINER SZEKELY, PETER A				
ART UNIT		PAPER NUMBER		
1714				

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,888

Applicant(s)

BAJGUR ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim is broader than claim 1, the claim it depends from.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishihara 6,346,574, Khouri 6,423,768 or Miebach et al. 2003/0139504.

4. Claims 1, 4, 6, 8-11, 13-16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nodera et al. 6,150,443.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nodera et al. 6,150,443, Nishihara 6,346,574, Khouri 6,423,768 or Miebach et al. 2003/0139504.

Response to Arguments

7. Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive. Applicants have cited a veritable plethora of citations from different court decisions, however a couple of very relevant precedents have been left out. For example: It is well settled that "consisting essentially of" does not preclude the applied references' other ingredients unless applicants can establish that their presence would deleteriously affect obtaining the properties or use which applicants seek in the sole use of the commonly required additive(s). In re Herz 537 F.2d. 549,551-52, 190 USPQ 461 (CCPA 1976); In re Janakirama-Rao 317 F.2d. 951, 137 USPQ 893 (CPA 1963). And: When a species is clearly names, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App.& Inter. 1990. This means that "consisting essentially of" is not "consisting". Other flame retardants and additives are not excluded unless they interfere with the invention. Applicants are claiming a composition. Whether the polyhydric alcohols are used s mold releases, fluidizers, stabilizers, dispersion aids or fertilizers is completely immaterial. They just have to be present. As long as they are clearly named the invention is anticipated. The claim concentrations completely encompass applicants' claimed ranges. Unless applicants can show the criticality of their claimed ranges, the invention is anticipated. M.P.E.P 2131.03. That means applicants have to prove that a point covered by the reference but outside their claimed range is inferior to their claimed product. In the case of the obviousness rejection picking and choosing is permitted. In re Arkley, 455 F.2d at 587, 172 USPQ at 526. The motivation to include the polyhydric

alcohols does not have to be the same as that of applicants'. It is not necessary for the prior art reference to disclose the same property or utility as the claimed product to establish a prima facie case of obviousness under 35 U.S.C. paragraph 103. In *re* Dillon 919 F.2d. 688, 693, 16 USPQ 2d 1897, 1901, (Fed. Cir. 1990) (en banc). As far as the unexpected results of Table I are concerned, the only polymer tested is polyphenylene ether. Nodera et al. show both polystyrene and ABS from column 4, line 51 to column 5, line 36 and in column 9, lines 6-8 it is stated that the amount of flame retardant can be reduced in the presence of glycols, making applicants' unexpected results quite expected. The rejections are maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Application/Control Number: 10/065,888
Art Unit: 1714

Page 5

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
10/22/03